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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,781	06/29/2001	Marcus Peinado	MSFT-0264/148578.1	8894
41505	7590	05/20/2005	EXAMINER	
WOODCOCK WASHBURN LLP ONE LIBERTY PLACE - 46TH FLOOR PHILADELPHIA, PA 19103			PORTKA, GARY J	
			ART UNIT	PAPER NUMBER
			2188	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/896,781

Applicant(s)

PEINADO, MARCUS

Examiner

Gary J. Portka

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant's election without traverse of Group I, claims 1-18 in the reply filed on January 27, 2005 is acknowledged. Claims 19-39 have been canceled by Applicant. Claims 1-18 are pending.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Olarig et al., US 6,032,257.

4. As to claim 1, Olarig discloses a *method that determines if a device is trustworthy based upon the hardware interface between the processing device and a portable memory recording device* (see Abstract, col. 3 lines 18-34, col. 4 lines 4-7 and 57-61, col. 5 lines 38-55, and col. 6 lines 6-17 and 28-41; based on the hardware interface since first a device is detected during a bus discovery phase and a non-vendor device may be indicated as unauthorized, and second hardware components are encoded to perform a digitally authenticated handshake which passes checks and responses – both first and second steps use and require the correct interface). *The system* (i.e., 120, Fig. 3) *receives or has received data, this data is protected* as claimed since the system will not be

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able to access the portable device (i.e., floppy) if it does not authenticate properly.

5. As to claims 2-5, 11-14, and 18, in addition to as discussed above with regard to claim 1, Olarig discloses determining not recording outside of a class, the class being memories that run on that authorized system; also, memory not readable by device lacking the capability of interfacing the correct handshake signals.

6. As to claims 6-9 and 15-17, in addition to as discussed above with regard to claim 1, Olarig discloses the limited copying (inherent in authentication requirement for the system) feature is proprietary ("vendor-specific hardware"), and licensed (clearly the recited permitting is obtained for a manufacturer to make such a device, and such a manufacturer is bound by the operational specifications and thus rule governing usage as meant by the term license).

7. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagano et al., US 5,778,421.

8. As to claim 1, Nagano discloses *a method of recording data comprising receiving protected content at a processing device* (information processor, 10, 20, 30, see Abstract, Fig. 2), *determining that a portable memory recording device (40) is trustworthy based on a hardware interface between the processing device and the recording device* (see col. 1 lines 13-21, col. 2 line 47 to col. 3 line 27, col. 4 lines 44-67, col. 5 lines 33-50, col. 6 lines 65-67, col. 7 lines 1-35, and col. 7 line 48 to col. 8 line 13; based on the interface since the CD 41 must store proper name which is indicated via the interface, also, because the validation

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requires the contacters 26, 47), and *using the recording device to record the content onto a portable memory* (note the Abstract mentions magnetic disks and DVD-RAM, and thus the system pertains to recording as well as reading).

9. As to claims 2-5, 11-14, and 18, in addition to as discussed above with regard to claim 1, Nagano discloses *determining not recording outside of a class*, the class being memories that run on that authorized system; also, memory not readable by device lacking the capability of interfacing the correct security signals.

10. As to claims 6-9 and 15-17, in addition to as discussed above with regard to claim 1, Nagano discloses the limited copying (inherent in authentication requirement for the system) feature is proprietary (the entire system is protected by patent), and licensed (where the use of the invented security circuit and identifications is considered permitted by license, and such a user is bound by the operational specifications and thus rule governing usage as meant by the term license).

### ***Response to Arguments***

11. Applicant's arguments filed September 30, 2004 have been fully considered but they are not persuasive. Applicants requested clarification regarding the rejection over Nagano in a non-final action. Examiner responds that relevant sections of Nagano were already cited and simply not repeated for each claim. Hereinabove the citations have been moved with the group of claims 1-18, due to the election and cancellation of the other claims. The grounds of rejection have not changed, and therefore it is justified to make the rejection final.

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Applicants argue that it is unclear that the Olarig authentication code determines trustworthiness. Examiner disagrees; authentication determines authenticity, and thus trustworthiness, to the extent claimed. Applicants argue that in Olarig the determination is not made based on the hardware interface. Examiner disagrees; the authentication requires not only the use of the interface, but that the interface between the items is compatible to properly implement the handshake described. Applicants argue the Olarig does not determine a device will not record outside a class. Examiner disagrees; for example, a device that does not authenticate properly is determined to not record on any unauthorized medium. Applicants argue that Olarig does not teach determining with less than absolute certainty, but Examiner maintains that such a limitation is inherent in any authentication system. Applicants argue that Olarig does not teach a defined feature required for devices to read a memory. Examiner disagrees; the defined feature is the capability of interfacing the correct handshake as previously described. Applicants argue that Olarig does not teach a proprietary feature. Examiner disagrees; the argument does not identify any particular definition given for the term in the disclosure, rather, the term appears to be given a broad interpretation. Thus the term may be reasonably interpreted to mean "exclusively owned" or "privately owned", and thus equal to the meaning of the reference term "vendor-specific". Applicants argue that no showing was made of proprietary hardware interface, but Examiner responds that vendor-specific hardware that includes an interface contains a proprietary interface. Applicants argue that the limited copying of Olarig does not teach the specific license structure claimed.

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Examiner responds that no specific license structure is claimed and that the term is read as described in the specification as a rule governing usage; thus, limited copying reads on the intended meaning of the term in the claims.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary J. Portka whose telephone number is (571) 272-4211. The examiner can normally be reached on M-F 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on (571) 272-4210. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary J Portka  
Primary Examiner  
Art Unit 2188

May 16, 2005